

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

It is noted that on November 24, 2003, Applicant filed a Claim for Priority under 35 U.S.C. § 119 and a certified copy of the priority document for German Patent Application 102 50 540.3, filed October 29, 2002. However, in the Office Action Summary, item 12, the Examiner has not acknowledged receipt of the Claim for Priority or certified copy. Such an acknowledgement in the next communication from the Patent Office would be appreciated.

Claims 1-10 remain in the application and are subject to examination. No claims have been withdrawn, amended, added or canceled.

In "Claim Rejections - 35 USC § 103" on pages 2-3 of the above-identified Office Action, claims 1 and 2 have been rejected as being obvious over U.S. Patent Application Publication No. US 2003/0002272 to Suehiro et al.

(hereinafter Suehiro) in view of Japanese Application No. 62114249 to Higuchi et al. (hereinafter Higuchi) under 35 U.S.C. § 103(a).

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and, therefore, the claims have not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 1 calls for, *inter alia*, a method for producing an optoelectronic component, which comprises:

providing an optoelectronic transducer mounted on a support with inner flat conductors and outer flat conductors;

embedding the transducer and the inner flat conductors in a plastic housing; and

milling the plastic housing to form a radiation-optical functional surface for a coupling partner from a material of the plastic housing.

Claim 2 calls for forming the radiation-optical functional surface in alignment with the transducer.

The Suehiro reference discloses a light-emitting diode 21 having a light-emitting element 2 mounted on a white substrate 16 having a circuit pattern. A frame 17 on the substrate 16 surrounds element 2. A fluorescent substance 15 is disposed on the surfaces of the substrate 16 and the frame

17. A hollow portion in the fluorescent face is filled with transparent epoxy resin 18 which has a radiating surface 19.

Suehiro fails to disclose a method including the step of milling a plastic housing to form a radiation optical functional surface for a coupling partner from a material of the plastic housing. Suehiro provides no motivation for a person skilled in the art to choose milling rather than another process in order to form a radiation optical functional surface in the plastic housing.

The Higuchi reference discloses a method for manufacturing a printed circuit board, in which a portion 3a of plated leads 3 is mechanically removed by cutting before finishing. A printed circuit board 2 is obtained by pressing along lines L. A mounting recess 4 for receiving a chip 6 is formed by cutting, such as milling, the board 2 to form a carrier A. A die 5 is bonded to the recess 4 for the chip 6 and a connection to a wire 7 is provided.

The Examiner has cited Higuchi as disclosing cutting a material by milling. However, **Higuchi fails to teach an optoelectronic component or a method for assembling an electronic component.**

Higuchi discloses milling of the printed circuit board 2 to produce the recess 4 in which the semiconductor chip 6 may be mounted, in order to eliminate damage to the semiconductor chip due to static electricity charges.

Higuchi relates to producing printed circuit boards, which is a different technical area and would not be considered by a person skilled in the art of optoelectronic components when looking to provide an optoelectronic component. Therefore, Higuchi is not relevant prior art to the invention of the instant application.

Even if a person skilled in the art did consider the disclosure of Higuchi, the method according to independent claim 1 would not be rendered obvious. Higuchi gives no indication to the person skilled in the art that milling could be successfully used to form a radiation optical functional surface in the plastic housing of an optoelectronic component. The person skilled in the art would have no reasonable expectation that milling could be used to successfully form a radiation optical functional surface for a coupling partner from a material of the plastic housing of an optoelectronic component. Therefore, the person skilled in the art would have no incentive to use

milling to form a radiation optical functional surface as required by independent claim 1 of the instant application.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Applicant's own disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), *cert. den.*, 488 U.S. 825 (1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to modify Suehiro or Higuchi or to combine Suehiro's and Higuchi's teachings to arrive at the claimed invention. Further, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in Suehiro or Higuchi or from knowledge available to those skilled in the art.

Clearly, the cited art does not show milling a plastic housing of an optoelectronic component to form a radiation-optical functional surface, as recited in claim 1 of the instant application.

Since the cited art does not show milling a plastic housing of an optoelectronic component to form a radiation-optical functional surface, it cannot show forming the radiation-optical functional surface in alignment with the transducer, as recited in claim 2.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art. Dependent claim 2 is also believed to be patentable because it is dependent on claim 1.

Finally, Applicant appreciatively acknowledges the Examiner's statement that claims 3-10 "would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." In light of the above, Applicant respectfully believes that rewriting of claims 3-10 is unnecessary at this time.

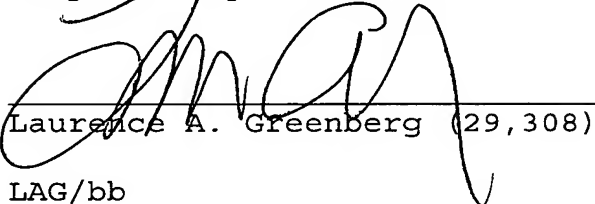
Appl. No. 10/695,580
Amdt. dated 11/1/05
Reply to Office action of 08/02/2005

In view of the foregoing, reconsideration and allowance of claims 1-10 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

If an extension of time is due, Petition for Extension is herewith made. Any extension or any other fees associated with this Response that might be due with respect to Sections 1.16 and 1.17 should be charged to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,



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